

REMARKS

Revocation of Power of Attorney

Applicant is enclosing herewith a Revocation of Power of Attorney and Appointment of New Attorney naming BRUCE H. TROXELL as attorney of record in this patent application. It is requested that all further correspondence regarding this matter be forwarded to TROXELL LAW OFFICE PLLC at the address listed on the enclosed form. A CHANGE OF ADDRESS FORM is also being submitted herewith.

Claim Rejections

Claims 1-5 and 9-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art in view of Pishel (U.S. 3,639,751). Claims 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art and Pishel and further in view of Schraefer (U.S. 4,415,954).

Drawings

Applicant proposes to amend Figure 3 as illustrated in red on the attached photocopy. In Figure 3 it is proposed to add reference number --2612--. No "new matter" has been added to the original disclosure by the proposed amendment to this figure. Approval of the proposed drawing changes is respectfully requested.

Amendments to Specification

Applicant has amended the specification as noted above to cure obvious grammatical and idiomatic inaccuracies and to correct the reference numbers to be consistent with the figures as originally filed with this application. No "new matter" has been added to the original disclosure by the foregoing amendments to the specification.

New Claims

By this Amendment, Applicant has canceled claims 1-20 and has added new claims 21-31 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a flashlight structure comprising: a casing (26) and having a power source (261); a housing (24) connected to an end of the casing and having a plurality of heat sinks (241) located on an exterior periphery thereof; a base (23) inserted into an interior of the housing adjacent to the plurality of heat sinks and having: an exterior peripheral surface engaging the interior of the housing along a length of the base; a conducting point (231) electrically connected to a positive terminal (2611) of the power source, a negative terminal (2612) of the power source is electrically connected to the base; and an isolation piece (232) isolating the conducting point; and a luminary (21) having an anode electrode (211) electrically connected to the conducting point and a cathode electrode (212) electrically connected to the base.

Other embodiments of the present invention include: the plurality of heat sinks are located on the housing between the luminary and the conducting point of the base; a holding sleeve (28) located on around an outer periphery of the casing; the holding sleeve is made of a heat-insulating material; the holding sleeve is made of a rubber material; a switch (27) connected to the power source for selectively controlling a power supply to the luminary; a reflective piece (22) located in the interior of the housing around the luminary, and a cover set (25) located on an end of the housing opposite the casing; the luminary is a light emitting diode; the base, the housing and the casing are made of a heat-conducting and electric-conducting material; the base, the housing and the casing are made of an aluminum alloy; and the housing and the base are integrally made.

Applicant's admitted prior art does not teach a housing having a plurality of heat sinks located on an exterior periphery thereof; a base inserted into an interior of the housing adjacent to the plurality of heat sinks; nor does Applicant's admitted

prior art teach the plurality of heat sinks are located on the housing between the luminary and the conducting point of the base.

Pichel teaches a thermally dissipative enclosure including a housing shell (10) having a cavity (18) and a plurality of fins located on an exterior of the housing, and a receptacle (14) connected to a bulb (28). The receptacle (14) is either located within the housing shell but spaced apart from an interior surface thereof or on an exterior of the housing shell.

Pichel does not teach a base inserted into an interior of the housing adjacent to the plurality of heat sinks; the base having an exterior peripheral surface engaging the interior of the housing along a length of the base; nor does Pichel teach the plurality of heat sinks are located on the housing between the luminary and the conducting point of the base.

The secondary reference to Schaefer teaches a grip shield including a vinyl sleeve (20) located on a barrel (14).

Schaefer does not teach a housing having a plurality of heat sinks located on an exterior periphery thereof; a base inserted into an interior of the housing adjacent to the plurality of heat sinks; the base having an exterior peripheral surface engaging the interior of the housing along a length of the base; nor does Schaefer teach the plurality of heat sinks are located on the housing between the luminary and the conducting point of the base.

Even if the teachings of Applicant's admitted prior art, Pichel, and Schaefer were combined, as suggested by the Examiner, the resultant combination does not suggest: a base inserted into an interior of the housing adjacent to the plurality of heat sinks; nor does the combination suggest the plurality of heat sinks are located on the housing between the luminary and the conducting point of the base.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over

40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Applicant's admitted prior art, Pichel, or Schaefer that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Applicant's admitted prior art, Pichel, nor Schaefer disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: February 14, 2005

By:


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Application No. 10/612,899

IN THE DRAWINGS:

Please amend Figure 3 as illustrated in red on the attached photocopy.

